

REMARKS

The Final Office Action mailed November 28, 2006, has been received and reviewed. Claims 1 through 10 are currently pending in the application. Claims 1 through 10 stand rejected. Applicant proposes to amend claims 1 and 8, and respectfully requests reconsideration of the application as proposed to be amended herein.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 6,387,473 to Sismondi et al. in view of U.S. Patent No. 6,183,844 to Li

Claims 1 through 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sismondi et al. (U.S. Patent No. 6,387,473) in view of Li (U.S. Patent No. 6,183,844). Applicants respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 1 through 10 are improper because the combined references do not teach all the claim limitations and actually teach away from the present invention.

Sismondi is relied upon as teaching an ink jet receiving sheet comprising a support and ink receiving layers on the support. The ink receiving layer is said to comprise glossiness improving agents, matting agents, a plasticizer, biocides and conventional additives. The Office Action acknowledges that Sismondi does not disclose the use of siloxane containing surfactant as the non-ionic surfactant. To overcome this deficiency, the Examiner relies on Li to show that a non-ionic surfactant by the tradename Silwet is "equivalent" to non-ionic surfactants by trade

names Fluorad and Triton. However, Li discloses use of a surfactant and goes on to state that the “surfactant is considered not to be a part of the film-forming organic polymer” and, thus, is not equivalent of the ink-receiving layer as claimed in the present invention.

More specifically, independent claims 1 and 8 recite that the ink-receiving layer consists of at least one hydrophilic polymer, at least one cross-linking agent, at least one mordant, inorganic particles, at least one nonionic siloxane copolymer surfactant, and at least one nonsiloxane surfactant, wherein the at least one hydrophilic polymer is selected from the group consisting of polyvinyl alcohol, a copolymer of polyvinylalcohol with polyethyleneoxide, a copolymer of polyvinylalcohol with polyacrylic or maleic acid, acetoacetylated polyvinylalcohol, polyethylene oxide, hydroxyethyl cellulose, hydroxypropylmethyl cellulose, poly(N-ethyl-2-oxazoline), casein, starch, agar, carrageenan, cellulose, carboxymethyl cellulose, dextran, pullulan, gelatin, derivatives thereof, and mixtures thereof. In other words, the ink-receiving layer consists of all of these components (including surfactants and organic polymers) within a single ink-receiving layer. Claims 1 and 8 have been amended to further clarify that the at least one hydrophilic polymer, the at least one nonionic siloxane copolymer surfactant, and the at least one nonsiloxane surfactant are bound together. In direct contrast, Li expressly warns that the surfactant is considered not to be a part of the film-forming organic polymer. Thus, Li expressly teaches away from the present invention, since the surfactant is expressly described as not forming part of the organic polymer and is not taught to be bound to a nonsiloxane surfactant. As such, there can be no motivation to combine the two references as it would result in an inoperable print medium. If a proposed modification would render the prior art invention being modified inoperable for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01.

Additionally, Li states that “there are many available surfactants and combinations of surfactants which may be used. Examples of suitable surfactants include . . . Fluorad FC-170-C surfactant, . . . Triton X-405 surfactant, Silwet L-77 surfactant . . .” (col. 16, line 64 to col. 17, line 4) (emphasis added). Thus, a clear reading of this particular section of Li cited by the Examiner expressly recites a list of “suitable” and “available” surfactants that may be used in combination with other elements of a coating composition. However, there is no description,

suggestion, or teaching in Li stating that Silwet, Fluorad and Triton surfactants are "equivalent" to each other or that they are to be considered equivalent versions of non-ionic surfactants to a person of skill in the art, as suggested in the Office Action.

Claims 2-5, 7, 9, and 10 depend from independent claims 1, 6, and 8. Dependent claims of non-obvious independent claims are also non-obvious. *See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, Claim 2-5, 7, 9, and 10 are non-obvious and Applicant requests that the 35 U.S.C. § 103(a) rejection thereof be withdrawn.

In view of the foregoing, Applicant respectfully requests withdrawal of the present obviousness rejection and allowance of claims 1-10.

ENTRY OF AMENDMENTS

The proposed amendments to claims 1 and 8 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. Specific support for the amendments can be found in, for example, paragraph [0018] in conjunction with preceeding paragraphs [0013] to [0017]. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested in order to place the case in condition for appeal.

CONCLUSION

Claims 1 through 10 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain

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which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

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